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REMARKS/ARGUMENTS

Claims 9-14 are pending in this Application.

Applicants' counsel greatly appreciates the courtesies extended by the Examiner in the interview of August 24, 2004. In the interview, Applicants' counsel argued that the broad teaching in Ahiko et al. that the chip-type electronic component can be a combined component including two or more of a capacitor, inductor, resistor, thermistor, varistors and the like, cannot be fairly construed as teaching the unique combination of features and method steps recited in Applicants' claim 9. In addition, Applicants' counsel argued that Ahiko et al. fails to teach or suggest any diffusion-prevention layer and certainly fails to teach or suggest a diffusion-prevention layer which is sandwiched between an inductor characteristic sheet and a thermistor characteristic sheet in a compound multilayer body. The Examiner indicated that, pending a further review of Ahiko et al., she might need to apply another prior art reference which teaches a diffusion-prevention layer. No agreement was reached with respect to the patentability of Applicants' claim 9.

Claims 9, 11 and 14 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ahiko et al. (US 2001/0019176). Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ahiko et al. in view of Person et al. (U.S. 5,321,573). Claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ahiko et al. in view of Nagakubo et al. (U.S. 5,966,938). Applicants respectfully traverse the rejections of claims 9-14.

Claim 9 recites:

"A manufacturing method of a chip-type composite electronic component comprising the steps of:

forming an inductor characteristic sheet by laminating a ceramic layer having an internal coil conductor;

forming a thermistor characteristic sheet having a predetermined resistance-temperature characteristic by laminating a plurality of ceramic layers, each of at least two adjacent ceramic layers of the plurality of ceramic layers includes an internal

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electrode, wherein the internal electrode of one of the at least two adjacent ceramic layers extends from a central portion to a first edge of the ceramic layer, and the internal electrode of the other of the at least two adjacent ceramic layers extends from a central portion to a second edge of the ceramic layer that is opposite to the first edge; forming a compound multilayer body by adhering the inductor characteristic sheet and the thermistor characteristic sheet by pressure with a diffusion-prevention layer sandwiched therebetween; baking a compound multilayer body; forming external electrodes on an end surface of a compound multilayer body in which at least one end part of an internal coil conductor and at least one end part of an internal electrode are exposed.” (emphasis added)

The Examiner alleged that Ahiko et al. teaches each and every feature and method step recited in Applicants' claim 9, including the steps of forming an inductor characteristic sheet, forming a thermistor characteristic sheet, and forming a compound multilayer body by adhering the inductor characteristic sheet and the thermistor characteristic sheet by pressure with a diffusion-prevention layer sandwiched therebetween. Applicants respectfully disagree.

The Examiner referred to paragraph 44 on page 3 of Ahiko et al. as allegedly teaching an inductor characteristic sheet and a thermistor characteristic sheet which are formed into a compound multilayer body.

Paragraph 44 on page 3 of Ahiko et al. discloses that “the chip-type electronic component according to the present invention may be any of various types of chip-type electronic components such as capacitors, inductors, resistors, thermistors, varistors and the like. It may also be a combined component achieved by combining these chip-type electronic components.”

This single paragraph in the Summary of the Invention of Ahiko et al. is the only portion of Ahiko et al. which even mentions a combined component. There is absolutely no teaching, suggestion or mention in Ahiko et al. of any specific structure or features of such a combined component or any specific method steps for manufacturing such a

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combined component. In fact, the Detailed Description of the Invention of Ahiko et al. is completely silent with respect to any combined component, and the drawings of Ahiko et al. fail to show any such combined component.

In addition, Ahiko et al. fails to teach or suggest any combined component which includes an inductor characteristic sheet that is formed by laminating a ceramic layer having an internal coil conductor, a thermistor characteristic sheet having a predetermined resistance-temperature characteristic formed by laminating a plurality of ceramic layers, each of at least two adjacent ceramic layers of the plurality of ceramic layers includes an internal electrode, wherein the internal electrode of one of the at least two adjacent ceramic layers extends from a central portion to a first edge of the ceramic layer, and the internal electrode of the other of the at least two adjacent ceramic layers extends from a central portion to a second edge of the ceramic layer that is opposite to the first edge and a compound multilayer body formed by adhering the inductor characteristic sheet and the thermistor characteristic sheet by pressure with a diffusion-prevention layer sandwiched therebetween as recited in Applicants' claim 9. In fact, Ahiko et al. fails to teach or suggest any combined component which includes an inductor characteristic sheet and a thermistor characteristic sheet, or any diffusion-prevention layer, let alone a diffusion-prevention layer that is sandwiched between an inductor characteristic sheet and a thermistor characteristic sheet.

Thus, neither paragraph 44 on page Ahiko et al. nor any other portion of Ahiko et al. can be fairly construed as teaching or suggesting the unique combination features and method steps recited in Applicants' claim 9.

The Examiner is reminded that a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Since Ahiko et al. neither expressly nor inherently describes the unique combination of method steps and features recited in Applicants' claim 9 for the reasons described above, Applicants respectfully submit that Ahiko et al.

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clearly fails to teach or suggest each and every element recited in Applicants' claim 9. Thus, Applicants respectfully submit that Ahiko et al. clearly fails to anticipate Applicants' claim 9 as required under 35 U.S.C. § 102(e).

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of Applicants' claim 9 under 35 U.S.C. § 102(e) over Ahiko et al.

In anticipation of the Examiner changing the rejection of Applicants' claim 9 to an obviousness rejection under 35 U.S.C. § 103(a) over Ahiko et al., Applicants respectfully submit that Ahiko et al. fails to render Applicants' claim 9 obvious.

The Examiner's allegation that paragraph 44 on page 3 of Ahiko et al. teaches a combined component including an inductor characteristic sheet and a thermistor characteristic sheet that are laminated together amounts to nothing more than an allegation that since Ahiko et al. broadly teaches that two or more of the chip-type electronic components disclosed in Ahiko et al. can be included in a combined component, it would have been obvious to try various combinations of electronic components including a combination of an inductor characteristic sheet and a thermistor characteristic sheet. However, the Examiner is reminded that whether a particular combination might be obvious to try is not a legitimate test of patentability. In re Geiger, 815 F.2d 868, 888, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987), In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988).

The Examiner is also reminded that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. In re Geiger, 815 F.2d 686, 2 USPQ 1276, 1278 (Fed. Cir. 1987). Since Ahiko et al. fails to provide any teaching, suggestion or incentive supporting a combination of an inductor characteristic sheet and a thermistor characteristic sheet with a diffusion prevention layer sandwiched therebetween, Applicants respectfully submit that Ahiko et al. does not render Applicants' claim 9 obvious.

Prior art rejections must be based on evidence. Graham v. John Deere Co., 383

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U.S. 117 (1966). Here, the Examiner has clearly failed to provide any evidence which teaches or suggests the unique combination of method steps and features recited in Applicants' claim 9, including the steps of "forming an inductor characteristic sheet by laminating a ceramic layer having an internal coil conductor," "forming a thermistor characteristic sheet having a predetermined resistance-temperature characteristic by laminating a plurality of ceramic layers, each of at least two adjacent ceramic layers of the plurality of ceramic layers includes an internal electrode, wherein the internal electrode of one of the at least two adjacent ceramic layers extends from a central portion to a first edge of the ceramic layer, and the internal electrode of the other of the at least two adjacent ceramic layers extends from a central portion to a second edge of the ceramic layer that is opposite to the first edge" and "forming a compound multilayer body by adhering the inductor characteristic sheet and the thermistor characteristic sheet by pressure with a diffusion-prevention layer sandwiched therebetween."

Even assuming *arguendo* that Ahiko et al. teaches a combined component including an inductor characteristic sheet and a thermistor characteristic sheet, Ahiko et al. still fails to teach or suggest any diffusion-prevention layer which is sandwiched between the inductor characteristic sheet and the thermistor characteristic sheet. Therefore, the Examiner has failed to even establish a *prima facie* case of obviousness (let alone a case of anticipation) of the claimed invention because all of the claimed features must be taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) and MPEP § 706.02(j) and § 2143.03.

Instead of basing the conclusion of obviousness on actual teachings or suggestions of the prior art and the knowledge of one of ordinary skill in the art at the time the invention was made, the Examiner has improperly used Applicants' own invention as a guide. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. The Federal Circuit has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in

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the prior art to deprecate the claimed invention. In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).

The Examiner has relied upon Person et al. and Nagakubo et al. to allegedly cure various deficiencies in Ahiko et al. However, Person et al. and Nagakubo et al. fail to teach or suggest the steps of "forming an inductor characteristic sheet by laminating a ceramic layer having an internal coil conductor," "forming a thermistor characteristic sheet having a predetermined resistance-temperature characteristic by laminating a plurality of ceramic layers, each of at least two adjacent ceramic layers of the plurality of ceramic layers includes an internal electrode, wherein the internal electrode of one of the at least two adjacent ceramic layers extends from a central portion to a first edge of the ceramic layer, and the internal electrode of the other of the at least two adjacent ceramic layers extends from a central portion to a second edge of the ceramic layer that is opposite to the first edge" and "forming a compound multilayer body by adhering the inductor characteristic sheet and the thermistor characteristic sheet by pressure with a diffusion-prevention layer sandwiched therebetween" as recited in Applicants' claim 9.

Accordingly, Applicants respectfully submit that Ahiko et al., Person et al. and Nagakubo et al., applied alone or in combination, fail to teach or suggest the unique combination and arrangement of elements recited in Applicants' claim 9. Claims 10-14 depend upon claim 9 and are therefore allowable for at least the reasons that claim 9 is allowable.

In view of the foregoing remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

In the event that the Examiner determines that the claims are not patentable, any subsequent prior art rejection of the claims in response to this Request for Reconsideration must be Non-Final since the claims are not amended herein and the new ground of rejection is not necessitated by any amendment on Applicants' part.

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The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

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